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10/022,972	12/13/2001	Edward P. Kuzemchak	TI-32964	7240

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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Notification of Non-Compliant Appeal Brief
(37 CFR 41.37)**

Application No.

10/022,972

Applicant(s)

KUZEMCHAK ET AL.

Examiner

Chih-Ching Chow

Art Unit

2191

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 22 March 2006 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer.
EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.

1. ☒ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☐ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☐ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☐ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☐ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☐ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☒ Other (including any explanation in support of the above items):

The filed brief does not contain the following items under appropriate headings and in the order indicated in paragraphs (c) (1) (viii), (c) (1) (ix), (c) (1) (x); on the appeal brief dated 11/21/2005, the (c), (1) (viii) section title is wrong, it should be "Claims appendix", on the appeal brief filed on 3/22/2006, this section is totally missing. The (c) 1 (xi) and (c) 1 (x) are missing in both copies, the section title should be included even there is no appendices are available; e.g. if there is no evidence being relied upon by appellant in the appeal, then an evidence appendix should be included with the indication "none", see attached pages.


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SUPERVISORY PATENT EXAMINER

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Examiner
Art Unit: 2191

the rule. The statement cannot include any argument concerning the merits of the ground of rejection presented for review. Arguments should be included in the "Argument" section of the brief.<

>(vii)< Argument. The appellant's contentions with respect to each **>ground of rejection<** presented ****** and the basis for those contentions, including citations of authorities, statutes, and parts of the record relied on, should be presented in this section. **>A statement which merely points out what a claim recites will not be considered an argument for patentability of the claim <**

>37 CFR 41.37(c)(1)(vii)< contains the following sentence:

Any arguments or authorities not included in the brief **>or reply brief** filed pursuant to § 41.41 **<** will be refused consideration by the Board ******, unless good cause is shown.

This sentence emphasizes that all arguments and authorities which an appellant wishes the Board to consider should be included in the brief **>or reply brief<**. It should be noted that arguments not presented in the brief **>or reply brief<** and made for the first time at the oral hearing are not normally entitled to consideration. *In re Chiddix*, 209 USPQ 78 (Comm'r Pat. 1980); *Rosenblum v. Hiroshima*, 220 USPQ 383 (Comm'r Pat. 1983).

>This sentence< is not intended to preclude the filing of a supplemental paper if new authority should become available or relevant after the brief **>or reply brief<** was filed. An example of such circumstances would be where a pertinent decision of a court or other tribunal was not published until after the brief **>or reply brief<** was filed.

>Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. The failure of appellant to separately argue claims which appellant has grouped together constitutes a waiver of any argument that the Board must consider the patentability of any grouped claim separately. See *In re McDaniel*, 293 F.3d 1379, 1384, 63 USPQ2d 1462, 1465-66 (Fed. Cir. 2002). Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number.

For example, if Claims 1 to 5 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. Y and appellant is only going to argue the limitations of independent claim 1, and thereby group dependent claims 2 to 5 to stand or fall with independent claim 1, then one possible heading as required by this subsection could be "Rejection under 35 U.S.C. 102(b) over U.S. Patent No. Y" and the optional subheading would be "Claims 1 to 5." Another example is where claims 1 to 3 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. Z and appellant wishes to argue separately the patentability of each claim, a possible heading as required by this subsection could be "Rejection under 35 U.S.C. 102 (b) over U.S. Patent No. Z," and the optional subheadings would be "Claim 1," "Claim 2" and "Claim 3." Under each subheading the appellant would present the argument for patentability of that claim. The best practice is to use a subheading for each claim for which separate consideration by the Board is desired.<

>(viii) Claims appendix.< An appendix containing a copy of the claims involved in the appeal.

The copy of the claims ****** should be a clean copy and should not include any markings such as brackets or underlining **>except for claims in a reissue application<**. See MPEP § 1454 for the presentation of the copy of the claims in a reissue application.

The copy of the claims should be double-spaced and the appendix should start on a new page.

(ix) Evidence appendix An appendix containing copies of any evidence submitted pursuant to 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See 37 CFR 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal. The appendix should start on a new page. If there is no evidence being relied upon by appellant in the appeal, then an evidence appendix should be included with the indication "none."

(x) Related proceedings appendix An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to 37 CFR 41.37(c)(1)(ii). The appendix should start on a new page. If there are no such copies of decisions being submitted in the appeal, then a related proceedings appendix should be included with the indication "none."

37 CFR 41.37(c)(1) merely specifies the minimum requirements for a brief, and does not prohibit the inclusion of any other material which an appellant may consider necessary or desirable, for example, a list of references, table of contents, table of cases, etc. A brief is in compliance with 37 CFR 41.37(c)(1) as long as it includes items (i) to (x) in the order set forth.

37 CFR 41.37(c)(2) prohibits the inclusion in a brief of any new or non-admitted amendment, affidavit or other evidence.

An example of a format and content for an appeal brief for a patent application is a brief containing the following items, with each item starting on a separate page:

- (A) Identification page setting forth the applicant's name(s), the application number, the filing date of the application, the title of the invention, the name of the examiner, the art unit of the examiner and the title of the paper (i.e., Appeal Brief);
- (B) Table of Contents page(s);
- (C) Real party in interest page(s);
- (D) Related appeals and interferences page(s);
- (E) Status of claims page(s);
- (F) Status of amendments page(s);
- (G) Summary of claimed subject matter page(s);
- (H) Grounds of rejection to be reviewed on appeal page(s);
- (I) Argument page(s);
- (J) Claims appendix page(s);
- (K) Evidence appendix page(s);
- (L) Related proceedings appendix page(s).

In accordance with the above, the brief must be directed to the claims and to the record of the case as they appeared at the time of the appeal, but it may, of course, withdraw from consideration on appeal any claims or issues as desired by appellant. Even if the appeal brief withdraws from consideration any claims or issues (i.e., appellant acquiesces to any rejection), the examiner must continue to make the rejection in the examiner's answer, unless an amendment obviating the rejection has been entered.

A timely filed brief will be referred to the examiner for consideration of its propriety as to the appeal issues and for preparation of an examiner's answer if the brief is proper and the application is not allowable. The examiner's answer may withdraw the rejection of claims, if appropriate. The examiner may also determine that it is necessary to reopen prosecution to enter a new ground of rejection. See MPEP § 1207.04.